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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,495	07/14/2004	Pierre Ducray	H-32268A	8264

1095 7590 12/07/2005

NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER

SACKEY, EBENEZER O

ART UNIT PAPER NUMBER

1626

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,495

Applicant(s)

DUCRAY ET AL.

Examiner

EBENEZER SACKY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1-8, 10 and 13-23 are pending.

Claims 9 and 11-12 have been cancelled.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed 07/14/04 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "obtainable according to the process or in another way" is indefinite because it is not clear if formula (I) is prepared by the instant process or formula (I) is prepared by another process. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

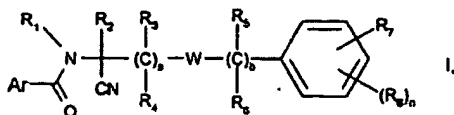
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 10, 13-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Andoh et al.,(U.S.Patent number 6,239,077)('077').

Applicants claim compounds and compositions containing compounds of structural formula (I), where the substituents are as defined in claim 1

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Andoh et al., discloses identical compounds and compositions containing the compounds. See for example compound number 297, column 15, Table 3.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

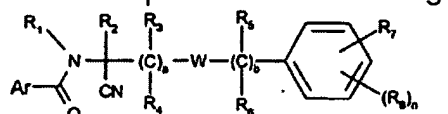
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6, 8,10 and 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andoh et al, (U.S.Patent number 6,239,077).

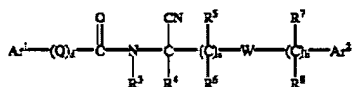
Applicants claim an aminoacetonitrile compound of structural formula (I), composition containing the compounds and method of using the said composition in controlling



parasites; the substituents are as defined in claim 1

Determination of the scope and content of the prior art (MPEP §2141.01)

Andoh et al., teach an aminoacetonitrile compound and compositions for agricultural and horticultural use. See the entire reference, especially Table 3 and compound number 297, columns 15 and 17 respectively, wherein d is 0, a is 1, R₇ and R₈ are each hydrogen, Ar₂ is unsubstituted or substituted phenyl among



others

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compound and composition of the prior art and, the compound and compositions instantly claimed is that of generic description. The indiscriminate selection of "some" among "many" is *prima facie* obvious. *In re Lemin*, 141 USPQ 814 (1964). Additionally, Andoh et al., teaches the generic formula which encompasses instant claim 1 and claims depended therefrom and thus, the instant compounds may be easily derived from the generic formula in Andoh et al., and hence, all the motivation the skilled artisan needs to arrive at the instant compounds is to follow the generic formula of Andoh et al.

It is noted that claims 17, 18, 22 and 23 are drawn to specific parasites namely endoparasite and specifically helminthes. Andoh et al., do not disclose the treatment of any of these parasites. However, intended use is not given any patentable distinction. Claims 16 and 21 drawn to formulations consisting of for example suspensions are disclosed in column 27, lines 58-67.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

Hence, the motivation to prepare the claimed compounds and compositions derives from the expectation that compositions containing structurally similar compounds would possess virtually the same or similar activity (i.e., agricultural use).

Accordingly, it would have been *prima facie* obvious to one of ordinary skill in the art to prepare aminoacetonitrile compounds and compositions as disclosed by Andoh et al., with a reasonable expectation of success absent a showing of unexpected results. Therefore, at the time of filing this application, one of ordinary skill in the art in possession of Andoh et al., would have been in possession of the instant compounds and composition and method of use absent a showing of unexpected results and/or properties.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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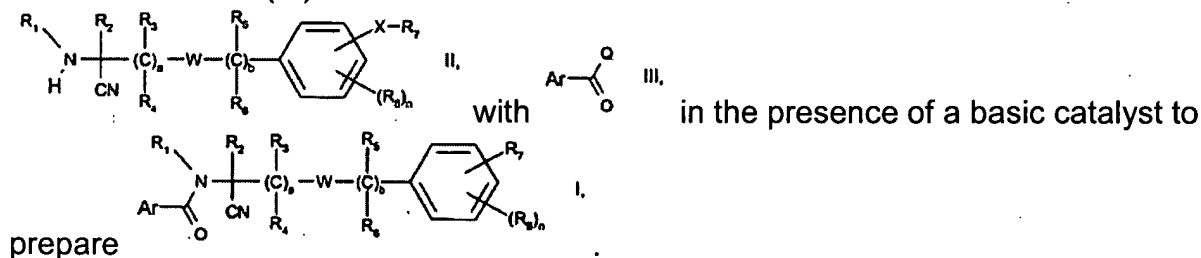
matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andoh et al, (U.S. Patent number 6,239,077).

Applicants claim a method for preparing an aminoacetonitrile compound of structural formula (I), which comprises a reaction of a compound of formula (II) with compound of structural formula (III) substituents are as defined in claim 7



Determination of the scope and content of the prior art (MPEP §2141.01)

Andoh et al., teach the preparation of an aminoacetonitrile compound for agricultural and horticultural use. See column 4, lines 25-62 of the reference.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Andoh et al., differs from the instant process in the use of analogous reactants in the presence of a basic catalyst.

An obviousness analysis requires that the prior art both suggest the claimed subject matter and reveal a reasonable expectation of success to one reasonable skilled in the art. *In re Vaeck*, 947 F .2d 488, 493, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991). The reaction conditions of claim 7 similar to the reference cited because it appears that the preparation was done under room temperature and pressure.

Hence, the real difference is the desire to prepare aminoacetonitrile. This difference is not expected to change the outcome of the reaction.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

Thus, at the time of filing this application, one of ordinary skill in the art in possession of Andoh et al., would have found the instant claim obvious. The requisite motivation being the desire to prepare aminoacetonitrile.

The instantly claimed process would therefore have been suggested to one of ordinary skill in the art absent a showing of unobvious or unexpected results and or properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

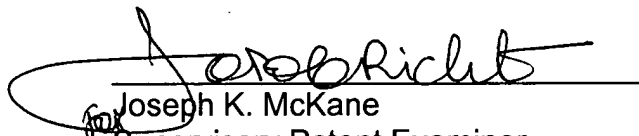
The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS
December 5, 2005



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1